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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CANTELMO, GREGG

ART UNIT PAPER NUMBER

1745

DATE MAILED: 10/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/743,585

Applicant(s)

BARTLING ET AL.

Examiner

Gregg Cantelmo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/22/03 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>SEE OFFICE ACTION</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statements filed December 22, 2003 and August 8, 2005 have been placed in the application file and the information referred to therein has been considered as to the merits.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the external surface of the cell having at least one air entry port comprising a curved surface must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. See item 5 below for further clarification.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New

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Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-4 and 6-32 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a range of loss stiffness and burst pressure, does not reasonably provide enablement for all loss stiffness values less than about 55,000 N/m (claims 1-4 and 6-32) and does not reasonably provide enablement for all average burst pressures of at least about 43 psi (claims 19-32). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. The infinite ranges set forth in these claims extend beyond the scope of which the claims are entitled to and require both an upper and lower bounds to the property therein, commensurate with the written description of the instant application.

4. Claims 1-32 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the particular disclosed tab systems, does not reasonably provide enablement for all material combinations which may exhibit the same claimed properties. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention

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commensurate in scope with these claims. It would require undue experimentation by one of ordinary skill in the art to determine which tab systems would constitute those systems which exhibit the same claimed characteristics. Furthermore it is unclear as to whether or not all materials which do exhibit such characteristics would have been appreciated by Applicant at the time the claimed invention was made and thus extends the claims beyond the scope of which the disclosed invention is entitled to.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3, 20 and 24 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

Claims 3, 20 and 24 recite that the external surface of the cell having at least one air entry port comprises a curved surface. However this arrangement is not readily understood in light of the disclosure of the instant application. The claims suggest that the air entry ports are formed on the curved surface of the cell, however it is apparent from the drawings and disclosure that the air entry ports are not formed on the curved surface of the cell but rather on the lower planar surface of the cell. If the claims are meant to simply define the shape of the external surface of the cell, then the claim should be amended to exclude the recitation of the air entry port. If the claims are meant to define the portion of the external surface of the cell where the air entry port(s) are disposed, then the external surface should be amended to define that particular surface as being a planar surface.

Claims 3, 20 and 24 have been interpreted in light of the specification such that the curved surface as claimed is not the surface which includes the air entry ports but rather the sidewall configuration of the cell (see Figs. 1 and 2).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-5, 9-10, 12, 14-17 and 19-26 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,649,090 (Oltman).

Oltman discloses a metal-air cell (title) comprising: at least one air entry port along an exterior surface of the cell (col. 4, ll. 35-45), and a tab system comprising a biaxially-oriented polypropylene paper (col. 4, ll. 15-20) and an acrylic adhesive disposed between the paper and the exterior surface of the metal air cell (col. 4, ll. 23-27). With respect to the claimed loss stiffness, the polymer layer of Oltman is a biaxially-oriented polypropylene paper applied via an acrylic adhesive. The instant application itself teaches that the polymer layer is also a biaxially oriented polypropylene layer applied via an acrylic adhesive (see Example 1). Since the prior art paper/adhesive combination appears to be substantially identical to at least some of those exemplified in the instant application, there is a reasonable expectation that the prior art paper of Oltman exhibits the same loss stiffness (claims 1, 5, 19, 22 and 23)

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peel strength (claims 2 and 21), oxygen permeability (claims 4, 21 and 25), and average burst pressure (claim 19).

Where applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the examiner may make a rejection under both 35 U.S.C. 102 and 103, expressed as a 102/103 rejection.

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)

In the case of the instant application the basis for expectation of inherency is based on the following: the polymer layer of Oltman is a biaxially-oriented polypropylene paper applied via an acrylic adhesive. The instant application itself teaches that the polymer layer is also a biaxially oriented polypropylene layer applied via an acrylic adhesive (see Example 1). Since the prior art paper/adhesive combination appears to be substantially identical to at least some of those exemplified in the instant application, there is a reasonable expectation that the prior art paper of Oltman exhibits the same loss stiffness (claims 1, 5, 19, 22 and 23) peel strength

(claims 2 and 21), oxygen permeability (claims 4, 21 and 25), and average burst pressure (claim 19).

The Examiner requires applicant to provide that that the prior art products do not necessarily or inherently possess the characteristics of his [or her] claimed product.

Whether the rejection is based on inherency' under 35 U.S.C. 102, on prima facie obviousness' under 35 U.S.C. 103, jointly or alternatively, the burden of proof is the same...[footnote omitted]." The burden of proof is similar to that required with respect to product-by-process claims. In re Fitzgerald, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980) (quoting In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977)).

The cell is a button-type cell, such shapes being known in the art as a cylindrical button shape (col. 4, ll. 5-7 as applied to claims 9 and 10). Button-type cells include curved side surfaces as readily apparent to one of ordinary skill in the art. Claims 3, 20 and 24 have been interpreted in light of the specification such that the curved surface as claimed is not the surface which includes the air entry ports but rather the sidewall configuration of the cell (see Figs. 1 and 2).

The first polymer layer, discussed above is a biaxially oriented polypropylene layer (as applied to claim 12).

The first polymer layer has a thickness in the range of 2.7 mils to 3.7 mils, and preferably 3.2 mils. This is equivalent to 0.0027" to 0.0037", and preferably 0.0032" (col. 4, ll. 15-22 as applied to claim 14).

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The seal tab is described as being cleanly removed (abstract) and thus would have no visible residue remaining on the cell (as applied to claim 15).

As discussed above, the adhesive is an acrylic adhesive (as applied to claim 16).

The tab system comprises a second polymer layer such as a polyester (col. 4, ll. 30-35 as applied to claim 17) or in the alternative, given that the polypropylene layer is a three-ply paper, includes plural biaxially oriented polypropylene layers (abstract as applied to claim 17).

Claim Rejections - 35 USC § 102/103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

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under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 18, 27 and 28 are rejected under 35 U.S.C. 102 (b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Oltman.

The teachings of Oltman have been discussed above and are incorporated herein.

The seal tab paper is a three-ply biaxially-oriented polypropylene material and thus is held to include first and second ply biaxially-oriented polypropylene layers (as applied to claims 18 and 28).

With respect to the tensile stress ratio being from 1:3 to 3:1, while Oltman does not teach this ratio, it is held that the biaxially oriented polypropylene layers exhibit inherent machine direction stress and transverse direction stress which, since not disclosed as being comparatively different between the two directions, is expectant to exhibit at least a 1:1 ratio. If not, then in the absence of a teaching of a varied ratio, one of ordinary skill in the art would first consider biaxially orienting the film in each direction with the same amount of stress in both the machine direction and transverse direction.

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

In the case of the instant application the basis for expectation of inherency is based on the following: the polymer layer of Oltman is a biaxially-oriented polypropylene paper applied via an acrylic adhesive. The instant application itself teaches that the polymer layer is also a biaxially oriented polypropylene layer applied via an acrylic adhesive (see Example 1). Since the prior art paper/adhesive combination appears to be substantially identical to at least some of those exemplified in the instant application, and since there is no explicit teaching of varying the stress between the transverse direction and machine direction there is a reasonable expectation that the prior art paper of Oltman exhibits at least a 1:1 tensile stress property.

The Examiner requires applicant to provide that that the prior art products do not necessarily or inherently possess the characteristics of his [or her] claimed product.

Whether the rejection is based on inherency' under 35 U.S.C. 102, on prima facie obviousness' under 35 U.S.C. 103, jointly or alternatively, the burden of proof is the same...[footnote omitted]." The burden of proof is similar to that required with respect to product-by-process claims. In re Fitzgerald, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980) (quoting In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977)).

Claim Rejections - 35 USC § 103

8. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oltman in view of WO 01/91224 (WO '224).

The teachings of Oltman have been discussed above and are incorporated herein.

The open-circuit voltage (OCV) of Lot-A of Oltman, identified as being the invention of Oltman, is between 1.203 and 1.263 (Table II as applied to claims 8).

The differences between Oltman and claims 6 and 7 are that Oltman does not teach of the cell comprising an active material that comprises zinc and an electrolyte that comprises KOH (claim 6) or of the cell comprising zero added mercury (claim 7).

WO '224 is drawn to zinc-air cells which employ a zinc active material and an electrolyte comprising KOH (page 8, ll. 11-24 as applied to claim 6). The cell is also a zero mercury added cell (page2, ll. 27-29).

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of Oltman by selecting the zinc active material and KOH electrolyte, since such materials are typical electrochemical elements in metal-air cells and, in particular, zinc air cells. The selection of a known material based on its suitability for its intended use supported a prima facie obviousness determination in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945) See also *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). MPEP § 2144.07.

It would have additionally been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of Oltman by designing the cell to have zero added mercury since mercury is hazardous to the environment and to the health of humans and animals and would have generated a battery which is compliant with the increased demand by the public and federal, state, and local governments to substantially decrease or eliminate mercury in all electrochemical cells, including button-type cells.

9. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oltman in view of U.S. Patent No. 5,328,778 (Woodruff) or U.S. Patent No. 6,265,102 (Shrim).

The teachings of Oltman have been discussed above and are incorporated herein.

The difference between claims 3, 20 and 24 and Oltman is that Oltman does not teach of the cell being a prismatic cell.

As discussed above, Oltman teaches that while button cells are exemplified, the invention of Oltman (the seal tab) can be used in conjunction with all types of metal-air cells (col. 4, ll. 3-7).

Prismatic metal-air cells is a well known alternative configuration for a metal-air battery as shown by Woodruff (Fig. 1) or Shrim (Fig. 7).

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of Oltman to alter the shape to any conventional battery shape for metal air cells, such as the prismatic configuration as

shown by Woodruff or Shrim since it would have provided for metal-air cell designs for particular electronic devices.

10. Claims 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oltman in view of WO '221.

Oltman discloses a metal-air cell (title) comprising: at least one air entry port along an exterior surface of the cell (col. 4, ll. 35-45), and a tab system comprising a biaxially-oriented polypropylene paper (col. 4, ll. 15-20) and an acrylic adhesive disposed between the paper and the exterior surface of the metal air cell (col. 4, ll. 23-27). With respect to the claimed loss stiffness, the polymer layer of Oltman is a biaxially-oriented polypropylene paper applied via an acrylic adhesive. The instant application itself teaches that the polymer layer is also a biaxially oriented polypropylene layer applied via an acrylic adhesive (see Example 1). Since the prior art paper/adhesive combination appears to be substantially identical to at least some of those exemplified in the instant application, there is a reasonable expectation that the prior art paper of Oltman exhibits the same loss stiffness (claims 29 and 31) peel strength (claim 29), oxygen permeability (claim 30), and average burst pressure (claim 29). The open-circuit voltage (OCV) of Lot-A of Oltman, identified as being the invention of Oltman, is between 1.203 and 1.263 (Table II as applied to claims 29).

Where applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the examiner may make a rejection under both 35 U.S.C. 102 and 103, expressed as a 102/103 rejection.

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)

In the case of the instant application the basis for expectation of inherency is based on the following: the polymer layer of Oltman is a biaxially-oriented polypropylene paper applied via an acrylic adhesive. The instant application itself teaches that the polymer layer is also a biaxially oriented polypropylene layer applied via an acrylic adhesive (see Example 1). Since the prior art paper/adhesive combination appears to be substantially identical to at least some of those exemplified in the instant application, there is a reasonable expectation that the prior art paper of Oltman exhibits the same loss stiffness (claims 29 and 31) peel strength (claim 29), oxygen permeability (claim 30), and average burst pressure (claim 29).

The Examiner requires applicant to provide that that the prior art products do not necessarily or inherently possess the characteristics of his [or her] claimed product.

Whether the rejection is based on inherency' under 35 U.S.C. 102, on prima facie obviousness' under 35 U.S.C. 103, jointly or alternatively, the burden of proof is the same...[footnote omitted]." The burden of proof is similar to that required with respect to product-by-process claims. In re Fitzgerald, 619 F.2d 67, 70, 205 USPQ 594, 596

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(CCPA 1980) (quoting *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977)).

The differences between Oltman and claims 29 are that Oltman does not teach of the cell comprising an active material that comprises zinc and an electrolyte that comprises KOH or of the cell comprising zero added mercury .

WO '224 is drawn to zinc-air cells which employ a zinc active material and an electrolyte comprising KOH (page 8, ll. 11-24). The cell is also a zero mercury added cell (page2, ll. 27-29).

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of Oltman by selecting the zinc active material and KOH electrolyte, since such materials are typical electrochemical elements in metal-air cells and, in particular, zinc air cells. The selection of a known material based on its suitability for its intended use supported a prima facie obviousness determination in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945) See also *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). MPEP § 2144.07.

It would have additionally been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of Oltman by designing the cell to have zero added mercury since mercury is hazardous to the environment and to the health of humans and animals and would have generated a battery which is compliant with the increased demand by the public and federal, state, and local

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governments to substantially decrease or eliminate mercury in all electrochemical cells, including button-type cells.

11. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oltman in view of WO '221 as applied to claim 29 above.

The teachings of Oltman have been discussed above and are incorporated herein.

The seal tab paper is a three-ply biaxially-oriented polypropylene material and thus is held to include first and second ply biaxially-oriented polypropylene layers (as applied to claims 18 and 28).

With respect to the tensile stress ratio being from 1:3 to 3:1, while Oltman does not teach this ratio, it is held that the biaxially oriented polypropylene layers exhibit inherent machine direction stress and transverse direction stress which, since not disclosed as being comparatively different between the two directions, is expectant to exhibit at least a 1:1 ratio. If not, then in the absence of a teaching of a varied ratio, one of ordinary skill in the art would first consider biaxially orienting the film in each direction with the same amount of stress in both the machine direction and transverse direction.

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the

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allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." Ex parte Levy, 17 USPQ2d*1461, 1464 (Bd. Pat. App. & Inter. 1990)

In the case of the instant application the basis for expectation of inherency is based on the following: the polymer layer of Oltman is a biaxially-oriented polypropylene paper applied via an acrylic adhesive. The instant application itself teaches that the polymer layer is also a biaxially oriented polypropylene layer applied via an acrylic adhesive (see Example 1). Since the prior art paper/adhesive combination appears to be substantially identical to at least some of those exemplified in the instant application, and since there is no explicit teaching of varying the stress between the transverse direction and machine direction there is a reasonable expectation that the prior art paper of Oltman exhibits at least a 1:1 tensile stress property.

The Examiner requires applicant to provide that that the prior art products do not necessarily or inherently possess the characteristics of his [or her] claimed product.

Whether the rejection is based on inherency' under 35 U.S.C. 102, on prima facie obviousness' under 35 U.S.C. 103, jointly or alternatively, the burden of proof is the same...[footnote omitted]." The burden of proof is similar to that required with respect to product-by-process claims. In re Fitzgerald, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980) (quoting In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977)).

Conclusion

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12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Linden non-patent literature is provided to show the conventional shape of a button cell.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregg Cantelmo whose telephone number is 571-272-1283. The examiner can normally be reached on Monday to Thursday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pat Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



gc

September 28, 2006

Gregg Cantelmo
Primary Examiner
Art Unit 1745